

**THIS OPINION WAS NOT WRITTEN FOR PUBLICATION**

The opinion in support of the decision being entered today  
(1) was not written for publication in a law journal and  
(2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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**Ex parte** HARUYUKI KOIZUMI,  
HAJIME IWAI, KOUJI ONO  
and HIDEKI CHUJYO

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Appeal No. 1996-3003  
Application 08/175,182<sup>1</sup>

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HEARD: JANUARY 11, 2000

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Before HAIRSTON, HECKER and LALL, **Administrative Patent  
Judges.**

HECKER, **Administrative Patent Judge.**

**DECISION ON APPEAL**

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<sup>1</sup> Application for patent filed December 29, 1993. According to applicants, this application is a continuation of Application 07/953,386, filed September 30, 1992, which is a continuation of Application 07/884,309, filed May 11, 1992, now U.S. Patent No. 5,175,422, issued December 29, 1992; which is a continuation of Application 07/537,134, filed June 13, 1990.

This is a decision on appeal from the final rejection of claims 3<sup>2</sup> through 11, all claims pending in this application.

The invention relates to a hand held image scanner. In particular, looking at Figure 1, light source 4 projects light through a transparent cover 3 onto script G. Reflected light from script G passes back into the image scanner through a different portion of transparent cover 3 and is reflected by mirrors 5 and 6 through objective lens 7 onto charge coupled device 8. Mounting board 40 is positioned above the optical path between mirror 6 and detector 8, and supports one or more electrical devices 42 which protrude through a top of casing

1. Representative independent claim 3 is reproduced as follows:

3. A hand held image scanner, comprising:

a light source;

a window through which a light emitted from said light sources passes to illuminate a script;

an optical system for receiving light reflected from said script through said window, said optical system comprising a first reflection surface for receiving and reflecting light reflected from said script, a second

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<sup>2</sup> It is noted that the amendment after final rejection, received Sept. 22, 1995 as Paper No. 19½, has not been acted upon. This amendment would improve the wording of claim 3, but not change the substance of the claim.

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reflection surface for receiving and reflecting light received from said first reflecting surface and a light detector for receiving and detecting light reflected from said second reflection surface;

a casing for housing said light source and optical system, said window being provided in said casing; and

a mounting board located within said casing and above an optical path between said second reflecting surface and said light detector, said mounting board being connected with at least one device which passes through said casing.

The Examiner relies on the following references:

Lyon	4,521,772	Jun. 4,
1985		
Chadima, Jr. et al. (Chadima)	4,766,300	Aug.
23, 1988		
Hashimoto et al. (Hashimoto)	4,924,199	May
8, 1990		(filed
May 18, 1987)		

Claims 3 through 11 stand rejected under 35 U.S.C.

§ 103 as being unpatentable over Hashimoto in view of Lyon and Chadima.

Since the Examiner's Answer does not state the statutory grounds of rejection, and the final rejection states "under 35 USC 012/103 [sic] as set forth previously in the rejections of record", we have resorted to the next previous rejection, Paper No. 10, mailed April 25, 1994. In Paper No. 10, the statutory grounds are clearly stated as 35 U.S.C. § 103 with Hashimoto in view of Lyon. Although Paper No. 10

states that references Nakayama, Swartz, and Knowles are cited as cumulative to Lyon, they have not been used in the rejection of the claims and we shall not rely on them. Also, the final rejection, Paper No. 14, mailed February 1, 1995, brings in the reference Chadima, justifying this by stating Chadima's use in a prior office action (in a parent application). Although the use of Chadima may raise questions as to whether the Paper No. 14 final rejection could be made final, Chadima was made part of the rejection of the claims in Paper No. 14, and any questions of the propriety of the finality of that rejection are moot since Appellants have gone forward with this appeal.

In addition, we note that the Examiner has conceded our characterization of the outstanding rejection wherein he states:

To simplify the issue, the appellants' characterization of the rejection as "Hashimoto in view of Lyon and Chadima" is accepted.  
(Answer-page 3.)

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the brief, reply brief, answer and supplemental answer for the respective details thereof.

OPINION

After a careful review of the evidence before us, we will not sustain the rejection of claims 3 through 11 under 35 U.S.C. § 103.

The Examiner has failed to set forth a *prima facie* case. It is the burden of the Examiner to establish why one having ordinary skill in the art would have been led to the claimed invention by the reasonable teachings or suggestions found in the prior art, or by a reasonable inference to the artisan contained in such teachings or suggestions. *In re Sernaker*, 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983). "Additionally, when determining obviousness, the claimed invention should be considered as a whole; there is no legally recognizable 'heart' of the invention." *Para-Ordnance Mfg. v. SGS Importers Int'l, Inc.*, 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995) (*citing W. L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1548, 220 USPQ 303, 309 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)).

Although the Examiner makes reference to Appellants' Figure 2 as prior art in the Answer, "prior art Figure 2" has not been stated as grounds for the rejections made by the

Examiner. Also, we agree with Appellants that their Figure 2 is not available as "prior art" because it was only acknowledged as "known" to the inventors. We do, however, agree with the Examiner that Appellants' Figure 2 clearly teaches everything recited in claims 3 through 7 and 9 through 11.

The Examiner has not indicated how Hashimoto and Lyon are combined, only noting, in Paper No. 10, the lens of Hashimoto and the PC board of Lyon. With respect to Chadima, the final rejection, Paper No. 14, states:

The "first" and "second" surfaces are shown in Chaddima (Fig. 4) and the mounting board 20 is clearly in a plane which is above the "second" reflector. To place the detector on the bottom of the board would be a trivial structural modification.

First, we see no motivation, stated or otherwise, for relocating Chadima's detector to the bottom of the board, other than Appellants' claim language. Second, even if one were to move Chadima's detector as suggested by the Examiner, and even if this detector relocation were to meet claim 3's recitation of the board being above the optical path, the Examiner has not shown where this would result in "said

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mounting board being connected with at least one device which passes through said casing." as claimed.

We agree with Appellants that "The three references cited by the Examiner, when considered individually or in combination, fail to teach or suggest the invention defined in Claim 3." (Brief-page 10.)

Thus, we will not sustain the 35 U.S.C. § 103 rejection of claim 3. The remaining claims on appeal also contain the above limitations discussed in regard to claim 3 and thereby, we will not sustain the rejection as to these claims.

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We have not sustained the rejection of claims 3  
through 11 under 35 U.S.C. § 103. Accordingly, the Examiner's  
decision is reversed.

***REVERSED***

Kenneth W. Hairston	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
Stuart N. Hecker	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
Parshotam S. Lall	)	
Administrative Patent Judge	)	

SNH/cam



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